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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,815	03/09/2001	Masahito Yamamoto	862.C2144	5395
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FITZPATRICK CELLA HARPER & SCINTO			PHAM, THIERRY L	
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2624

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/801,815

Applicant(s)

YAMAMOTO, MASAHIITO

Examiner

Thierry L. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 and 46-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 46-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 4/4/05.
- Claims 1-30, 46-52 are pending in application; wherein claims 49-52 are newly added.
- Amendment to the Title has been received and acknowledged.

Response to Arguments

Applicant's arguments, see page 17, filed 4/4/05, with respect to claims 46-48 have been fully considered and are persuasive. The 101 (non-statutory) rejections of claims 46-48 have been withdrawn.

Applicant's arguments, see pages 17-18, filed 4/4/05, with respect to the rejection(s) of claim(s) 1, 5, 16, 20, 46-47 under 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art reference due to newly added limitations "generating means for generating transfer information describing a combination of a plurality of devices on the basis of device information corresponding to each of the plurality of devices, the device information indicating that the device is actively executes data communication or that the device passively executes data communication" as amended in claims 1, 5, 16, 20, and 46-47.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 50-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not

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described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The following is a quotation of the first paragraph of 35 U.S.C. 112: The specification does not provide an adequate written description of the limitations as recited in claims 50-51, wherein “wherein the first device transfer data to a destination without a request from the destination if the first device information indicates that the first device actively executes data transfer, and the first device transfer data to a destination in accordance with a request fro the destination if the first device information indicates that the first device passively executes data transfer”; and “wherein the second device receives data from a source by sending a request to the source if the second device information indicates that the second device actively executes data reception, and the second devices receives data from a source without sending a request to the source if the second device information indicates that the second device passively executes data reception” respectively. The examiner is unable to locate any portion of an original filed specification that teaches these newly added limitations. Also, the examiner is unclear whether the newly added limitations are inherently features respective to devices that are communicate actively and/or passively; therefore, it does not enable one skilled in the art to make, use and/or practice the invention. For claims interpretations, herein the examiner interprets such cited limitations as the inherent features.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Preamble of claims 11-15, the applicants are referring to “a device” according to claim 10. The examiner is unclear whether the applicants are referring to “a system” and/or a specific device such as an input, output or proxy device. The examiner is also unclear what device is for performing limitations as cited in claims

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11-15. Herein, the examiner assumed cited limitations in claims 11-15 are performed either via printers 2-3 of fig. 1 or image scanner 1 of fig. 1 (Yamamoto).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 16-24, 46-47, and 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al (EP 975145), and in view of Beser (US 6370147).

Regarding claim 1, Yamamoto discloses a system (data communication print system, fig. 1) comprising:

- generating means (host computer 4 of fig. 1 for generating transfer path profile as shown in fig. 10) for generating transfer information (transfer path profile #2, fig. 10, fig. 8 shows how a transfer path profile is generated, col. 5, lines 48-50) describing a combination of a plurality of devices (i.e. input and output devices such as scanners and printers respectively, figs. 9-10, for example, SCAN 5 to LP5-3 and LP5-1) on the basis of device information (i.e. device profile information, fig. 7) corresponding to each of the plurality of devices (for each devices connected via a network, fig. 1);
- operation means (user control console, figs. 8-13, cols. 13-16) for causing a user to select transfer information from the generated transfer information;
- reception means (receiving input data from scanner via network, fig. 1, cols. 13-16) for receiving image data from an input device represented by the selected transfer information on the basis of the selected transfer information (fig. 10 shows a transfer path profile for transmitting image data SCAN 5 to LP5-3 and LP5-1); and
- transmission means (transmitting image data from scanner to printer via network, fig. 1, cols. 13-16) for transmitting the received image data to an output device (laser printer, fig. 1 and fig. 4) represented by the selected transfer information on the basis of the

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selected transfer information (based upon transfer path profile, i.e., “copy scan 5 to LP5-3”, fig. 10).

Yamamoto also discloses device information (device profile, fig. 7) includes a transfer protocol such as FTP, and LPD, but fails to teach and/or suggest whether this device is actively and/or passively execute data communication as shown in figs. 7-8 “transmission-mode: LPD/Passive, FTP/Passive” of the originally filed specification.

Beser, in the same field of endeavor for data communication system, teaches network devices such as printer and facsimile machine categorized as passively execute data communication and cable modem categorized as actively executes data communication (col. 27, lines 33-40).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying the device profile (fig. 7) of Yamamoto to include an indication that device profile as shown in fig. 7 is a passive device as taught by Beser because of a following reason: (●) the method allows passive network devices without implementing a dynamic host configuration protocol (abstract, Beser); (●) to accurately label which devices connected via a network is a passively and/or actively executing data communication; by doing so, it allows the system of Yamamoto to search efficiently, for example, searching devices profile that only passively executes data communication.

Therefore, it would have been obvious to combine Yamamoto with Beser to obtain the invention as specified in claim 1.

Regarding claim 2, Yamamoto further discloses the system according to claim 1, wherein said reception means transmits the selected transfer information (transfer path profile, fig. 10) to the input device in order to control the input device, and said transmission means (network, fig. 1) transmits the selected transfer information to the input device in order to control the output device.

Regarding claim 3, Yamamoto further discloses the system according to claim 1, further comprising announcement means (confirmation means, figs. 8-14, cols. 13-16) for announcing, to a network, device information (device information, fig. 7) containing

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information representing that said reception means controls the input device as an active device (devices that are available to communicate and transfer data, fig. 9) and information representing that said transmission means controls the output device as an active device.

Regarding claim 4, Yamamoto further discloses the system according to claim 1, wherein the transfer information contains a protocol (transfer protocol, fig. 10) used to transfer the data, a data format (data format, fig. 10) of the data to be transferred, and an address (network address, fig. 10) representing a destination to which the data is to be transferred (fig. 10).

Regarding claim 5, Yamamoto further discloses a system comprising:

- generating means (host computer 4 of fig. 1 for generating transfer path profile as shown in fig. 10) for generating transfer information (transfer path profile #2, fig. 10, fig. 8 shows how a transfer path profile is generated, col. 5, lines 48-50) describing a combination of a plurality of devices (i.e. input and output devices such as scanners and printers respectively, figs. 9-10, for example, SCAN 5 to LP5-3 and LP5-1) on the basis of device information (i.e. device profile information, fig. 7) corresponding to each of the plurality of devices (for each devices connected via a network, fig. 1);
- operation means (user control console (keyboard 33, fig. 5) for selecting input/output devices, figs. 8-13, cols. 13-16) for causing a user to select a desired transfer path corresponding to the generated transfer information;
- acquisition means (server 5 for acquiring transfer path profile, fig. 10, cols. 14-16) for acquiring transfer information corresponding to the selected transfer path; input means (scanner, fig. 1) for inputting image data at an input device represented of the acquired transfer information;
- and transmission means (network, fig. 1) for transmitting the input image data (transferring data from scanner 5 to printer 3 as shown in transfer path profile #2, fig. 10) from the input device to an external device represented by the acquired transfer information on the basis of the acquired transfer information.

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Yamamoto also discloses device information (device profile, fig. 7) includes a transfer protocol such as FTP, and LPD, but fails to teach and/or suggest whether this device is actively and/or passively execute data communication as shown in figs. 7-8 “transmission-mode: LPD/Passive, FTP/Passive” of the originally filed specification.

Beser, in the same field of endeavor for data communication system, teaches network devices such as printer and facsimile machine categorized as passively execute data communication and cable modem categorized as actively executes data communication (col. 27, lines 33-40).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying the device profile (fig. 7) of Yamamoto to include an indication that device profile as shown in fig. 7 is a passive device as taught by Beser because of a following reason: (●) the method allows passive network devices without implementing a dynamic host configuration protocol (abstract, Beser); (●) to accurately label which devices connected via a network is a passively and/or actively executing data communication; by doing so, it allows the system of Yamamoto to search efficiently, for example, searching devices profile that only passively executes data communication.

Therefore, it would have been obvious to combine Yamamoto with Beser to obtain the invention as specified in claim 5.

Regarding claim 6, Yamamoto further discloses the system according to claim 5, wherein said transmission means transmits the input image data to a proxy device (file server, fig.1, cols. 13-16) represented by the acquired transfer information, and said proxy device transfers the received image data to an output device represented by the acquired transfer information (transferring data based upon transfer path profile s shown in fig. 10) in accordance with a request from the output device.

Regarding claim 7, Yamamoto further discloses the system according to claim 5, wherein said transmission means transmits the input image data to a proxy device represented by the acquired transfer information, and said proxy device (server, fig. 1,

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cols. 13-16) transfers the received image data by controlling an output device represented by the acquired transfer information in accordance with the acquired transfer information.

Regarding claim 8, Yamamoto further discloses the system according to claim 5, wherein said transmission means transmits the acquired transfer information to the external device (i.e., printer, fig. 1).

Regarding claim 9, Yamamoto further discloses the system according to claim 5, wherein the transfer information contains a protocol (protocol, fig. 10) used to transfer the data, a data format of the data to be transferred (data format, fig. 10), and an address (address, fig. 10) representing a destination to which the data is to be transferred (transfer path profile, fig. 10).

Regarding claims 16-24: Claims 16-24 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 1-9 (respectively); therefore, claims 16-24 are rejected for the same rejection rationale/basis as described in claims 1-9 above.

Regarding claims 46-47: Claims 46-47 recite limitations that are similar and in the same scope of invention as to those in claims 1 & 5 (respectively) except computer readable memory for storing computer programs. All computers/printers have some type of computer readable medium (i.e. RAM 41, fig. 5 of Yamamoto) for storing computer programs, hence claims 46-47 would be rejected using the same rationale as in claims 1 & 5 (respectively).

Regarding claim 49, Yamamoto discloses a computer comprising:

- first acquisition means (server 5 for acquiring transfer path profile, fig. 10, cols. 14-16) for acquiring first device information corresponding to first device (i.e. device profile for input device as shown in fig. 7);

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- second acquisition means for acquiring second device information corresponding to second device (i.e. device profile for output device as shown in fig. 34);
- generating means for generating transfer information (host computer 4 of fig. 1 for generating transfer path profile as shown in fig. 10) describing a combination of a plurality of devices on the basis of the acquired first device information and the acquired second device information (fig. 10 shows a transfer path profile for transmitting image data SCAN 5 to LP5-3 and LP5-1).

Yamamoto also discloses device information (device profile, fig. 7) includes a transfer protocol such as FTP, and LPD, but fails to teach and/or suggest whether this device is actively and/or passively execute data communication as shown in figs. 7-8 “transmission-mode: LPD/Passive, FTP/Passive” of the originally filed specification.

Beser, in the same field of endeavor for data communication system, teaches network devices such as printer and facsimile machine categorized as passively execute data communication and cable modem categorized as actively executes data communication (col. 27, lines 33-40).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying the device profile (fig. 7) of Yamamoto to include an indication that device profile as shown in fig. 7 is a passive device as taught by Beser because of a following reason: (●) the method allows passive network devices without implementing a dynamic host configuration protocol (abstract, Beser); (●) to accurately label which devices connected via a network is a passively and/or actively executing data communication; by doing so, it allows the system of Yamamoto to search efficiently, for example, searching devices profile that only passively executes data communication. Therefore, it would have been obvious to combine Yamamoto with Beser to obtain the invention as specified in claim 49.

Regarding claims 50-51, Beser further teaches the apparatus according to claim 49, wherein the first device transfers data to a destination without (without implementing a host protocol, abstract, Beser) a request from the destination if the first device information indicates that the first device actively executes data transfer, and the first

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device transfers data to a destination in accordance with a request from the destination if the first device information indicates that the first device passively executes data transfer.

Regarding claim 52, Beser further teaches the apparatus according to claim 49, wherein the first device information indicates data transfer being executed actively or passively by the first device for each protocol teaches network devices such as printer and facsimile machine categorized as passively execute data communication and cable modem categorized as actively executes data communication (col. 27, lines 33-40) with which the data transfer is performed in compliance therewith and the second device information indicates data transfer being executed actively or passively by the second device for each protocol with which the data transfer is performed in compliance therewith, and wherein the generated transfer information describes the combination of the plurality of devices and a protocol used between the plurality of devices.

Claims 10-15, 25-30, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al (EP 975145), and in view of Iida (US 6671063).

Regarding claim 10, Yamamoto discloses a system comprising:

- generating means for generating transfer information describing a combination of a plurality of devices on the basis of device information corresponding to each of the plurality of devices;
- acquisition means for acquiring the transfer information;
- reception means for receiving the image data from an external device represented by the acquired transfer information through a network.

Yamamoto discloses a system for acquiring devices (i.e. scanner and printer) information and to generate a transfer path profile between input and output devices as shown in fig. 10, but fails to teach a proxy device information, which converts (conversion means) image data into a data format.

Iida, in the same field of endeavor for print system (fig. 3), teaches a proxy device, which converts image data into a data format (a networked facsimile apparatus

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201 having a server section 12 and including a conversion unit 14 for converting image data into a data format, fig. 2-4, col. 7, lines 8-15).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying the image scanner (fig. 7) of Yamamoto to include a proxy device for converting image data into a data format as taught by Iida because of a following reason: (●) by replacing and/or modifying an image scanner 1 and/or printer 4 of Yamamoto to an image forming apparatus of Iida to include an server section (proxy device) including a conversion means for converting image data into a data format; by doing so, it reduces costs of implementing an additional hard ware, i.e., a separate print server for converting image data into a data format. In addition, Yamamoto also teaches a method for converting image data into an output data format such as PDL are known in the art (col. 28, lines 5-16). Please notes: Yamamoto also teaches a host computer 4 connected to a plurality of input and output devices via a network as shown in fig. 1, it is known in the art that host computer 4 also having a function for converting image data into an output format.

Therefore, it would have been obvious to combine Yamamoto with Iida to obtain the invention as specified in claim 10.

Regarding claim 11, Yamamoto further discloses the device according to claim 10, further comprising announcement means (confirmation means, figs. 8-14, cols. 13-16) for announcing, to the network, information representing a data format receivable by said reception means and information representing a data format transmittable by said transmission means.

Regarding claim 12, Yamamoto further disclose the device according to claim 10, wherein said conversion means performs at least one of conversion of the data format (i.e. lipsiv data format, fig. 10 and fig. 23), conversion of an image resolution, and conversion of an image depth (fig. 10).

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Regarding claim 13, Yamamoto further discloses the device according to claim 10, wherein said conversion means performs at least one of image trimming, image enlargement, image reduction, image deformation, image edge extraction, and image color conversion (converting image data into specified resolution, figs. 23-24).

Regarding claim 14, Yamamoto further discloses the device according to claim 10, wherein said conversion means performs at least one of conversion of the image data to coded data by encoding processing such as character recognition, conversion of the image data to a structured image format by image region separation processing and encoding processing, and conversion of coded data to the image data by rasterization image processing (rasterization, col. 21).

Regarding claim 15, Yamamoto further discloses the device according to claim 10, wherein said conversion means performs conversion of a data compression scheme (JPEG compression, figs. 23-25) or conversion of a data compression ratio.

Regarding claims 25-30: Claims 25-30 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 10-15 (respectively); therefore, claims 25-30 are rejected for the same rejection rationale/basis as described in claims 10-15 above.

Regarding claim 48: Claim 48 recite limitations that are similar and in the same scope of invention as to those in claim 10 except computer readable memory for storing computer programs. All computers/printers have some type of computer readable medium (i.e. RAM 41, fig. 5 of Yamamoto) for storing computer programs, hence claim 48 would be rejected using the same rationale as in claim 10.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

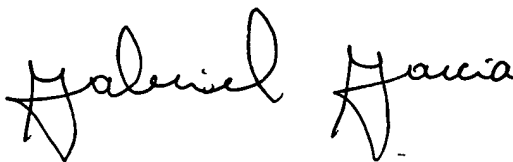
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA
PRIMARY EXAMINER